

REMARKS

Claims 16 and 17 remain pending in the application.

Status

Claims 16 and 17 were previously determined to be allowable, subject to amendments as designated at page 6 of the Office Action dated January 2, 2009 (See, also, Advisory Action of February 26, 2009, listing Claims 16 and 17 as "objected to.") Those amendments were made in the RCE and response filed March 23, 2009, and all other claims were cancelled without prejudice. In the Office Action of April 1, 2009, no new references were cited against the claims; nevertheless, Claims 16 and 17 now stand rejected, as discussed below.

For the record, no rationale for the apparent withdrawal of the determination of allowability has been given by the Examiner. Indeed, in the Office Action of April 1, 2009, the Examiner merely states: **Applicant's arguments filed 8 July 2008 have been considered but are moot in view of the new ground(s) of rejection.** Office Action page 9. Absolutely no mention is made of the previous determination of allowability nor of the response filed March 23, 2009. Unfortunately, this has resulted in piecemeal and delayed prosecution of Claims 16 and 17. Such delay should be taken into account when considering the term of any patent relating to said claims.

Formal Matters

For the record, there are no objections or rejections under §112 outstanding.

Previous Arguments

For the record, all previous arguments made in support of patentability continue to apply, but will not be exhaustively repeated herein for the sake of brevity.

Rejections Under 35 USC 102

Claim 16 stands rejected under §102 over US 6,632,347, for reasons of record at pages 3-4 of the Office Action.

Applicants respectfully traverse the rejection on this basis.

Before turning to the specific grounds of rejection, it may be useful to consider the controlling law with regard to anticipation under §102.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053, (Fed. Cir. 1987), MPEP §2131 [emphasis supplied]. “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), MPEP §2131 [emphasis supplied]. Moreover, the elements must be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

As previously discussed with regard to the earlier rejection of Claim 1 in the response filed December 8, 2008, the ‘347 patent expressly teaches the use of a membrane in its disclosed electrolysis cell. See, for example, column 4, line 35, column 14, line 25 and lines 40, 55 and 60.

In sharp contrast, Claim 16 (and, indeed, Claim 17) requires [element “b”) a non-membrane electrolysis cell. Accordingly, the ‘347 patent does not disclose, “. . . the identical invention . . .,” *Richardson, ibid.* of the claim. Therefore, it is submitted that the rejection of Claim 16 under §102 cannot stand, as a matter of law. Withdrawal of the rejection on that basis is requested.

Rejections under 35 USC 103

The rejection of Claim 9 (Office Action pages 4-5) appears to be in error, since Claim 9 was previously cancelled.

Claim 16 stands rejected under §103 over US 6,306,281 and US 6,632,347, for reasons of record at pages 5-7 of the Office Action. In making this rejection, the Examiner also refers to “claim 1” (Office Action pages 5-6), which was previously cancelled.

Claim 17 stands rejected over ‘281 in view of ‘347 and further in view of US 5,106,465, for reasons of record at pages 7-9.

Applicants respectfully traverse all rejections under §103.

When considering the technology defined by Claim 16 and 17, the Examiner's attention is first directed to the disclosure at page 3, lines 6-15 of the specification. There, Applicants discuss the disadvantages of electrolysis cells that use membranes or diaphragms, i.e., blockage by precipitated calcium or magnesium ions present in the water supply. Of course, this problem is avoided herein by using the non-membrane cell, as specified in both Claim 16 and Claim 17.

It is respectfully submitted that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP§2143.03 [case citations omitted].

With regard to Claim 16, as noted above, the '347 patent employs a membrane. Accordingly, in that regard it can be fairly said to teach away from the present invention and, therefore, is not properly citable against the claim.

Turning to '281, the Examiner's attention is again particularly directed to the Applicants' previous argument (response filed July 8, 2008, page 13) regarding the claim feature reciting the "source" of the element "a." Again, it is submitted that '281 fails to disclose or otherwise suggest means for locally delivering halogen dioxide salt directly to an aqueous feed solution inlet stream.

Overall Net: In light of the controlling case law, the above discussion and the arguments that have been submitted in the previous responsive amendments, it is requested that the rejection of Claim 16 over '281 and '347 be reconsidered and withdrawn.

With regard to the rejection of Claim 17 over the '281/'347/'465 combination, the foregoing remarks regarding '281 and '347 apply equally. Importantly, since '281 teaches a cell that operates in the absence of a membrane and '347 requires a membrane, those two documents teach away from each other and are not properly combinable to make the purported rejection of Claim 17. MPEP 2145X.D.2. (citing the *Grasselli* case).

Likewise, the '465 patent teaches a cell that employs a membrane (column 3, line 23; column 4, lines 34-35 and line 65) and, thus, like '347, teaches away not only from the present invention, but also from '281. Again, the MPEP 2145X.D.2. comes into play and prevents the cited combination under §103.

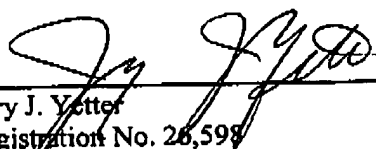
Overall Net: In view of the controlling law, the above discussion and the arguments that have been previously submitted, it is requested that the rejection of Claim 17 over the combination of '281/'347/'465 be reconsidered and withdrawn.

Early and favorable action on Claims 16 and 17 is respectfully requested.

Respectfully submitted,

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